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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,433	03/10/2004	Thomas Michael St. James	0521-0001	4447
26568	7590	06/08/2005	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			BARRETT, SUZANNE LALE DINO	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/797,433

Applicant(s)

JAMES, THOMAS MICHAEL ST.3

Examiner

Suzanne Dino Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 13-18, 23, 25-31, 36, 37 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13-18, 23, 25-31, 36, 37 and 40-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 4/13/05, 3/29/05.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings were received on 5/27/05. These drawings are approved.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,4-6,13,14,17,23,25,27-30,36,37,40-53, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanutti 5,477,710 in view of Stanich 4,882,918 and Dohanyos 4,106,315. Stefanutti clearly teaches a padlock body and shackle shield member having skirt/shroud sides to encompass a padlock therein and comprising integrally formed angled arms 6 which have elongate holes 16,18 therein laterally spaced to receive the legs of a padlock shackle. Stefanutti fails to teach vertically offset holes and an upper end having a skirt or shroud. Stanich teaches a padlock protector comprising a shield having a rear surface with vertically offset portions (15,22) and with integral arm members having shackle receiving openings (18,19a) therein and wherein the laterally and vertically offset arms receive the curved shackle (S) accordingly. With respect to claims 44,45,48,49,52,53 the shield further provided with a semicircular cutout (at 22 in Fig. 4) in the lower end to receive a combination dial therein and an

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access opening in the front face (at 11 in Fig.1). With respect to claims 46,50, Figure 10 of Stanich shows a lower end of the shield having an offset portion in a spaced, parallel plane. Furthermore, Stanich teaches the use of indicia on the face of the shield (see figures 1,17,19 especially, indicating a heart, unicorn or soccer ball – note in col. 6, lines 13-17 that Stanich teaches “virtually any shape” may be used). Dohanyos teaches a similar padlock shield assembly substantially encompassing the padlock and shackle and wherein the shield has side portions and an upper skirt/shroud portion 96. It would have been obvious to one of ordinary skill in the art to modify the shield of Stefanutti by vertically spacing the shackle holes, providing a semicircular cutout for the padlock face and providing indicia on the shield, all as taught by Stanich to securely receive the padlock within the shield and limit movement therein which could lead to tampering. It is noted that the method limitations of claim 37 are considered inherent to the use of the device as disclosed by Stefanutti and Stanich.

4. Claims 3,15,16,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanutti '710 in view of Stanich '918 as applied to claims 1,14,25 above, and further in view of Wightman 5,303,568. Stefanutti fails to specify the material used for the shield. Wightman teaches a padlock shackle shield comprised of a hardened steel. Accordingly, it would have been considered an obvious matter of design choice in providing a rigid construction to the shield to provide a well known hardened metal alloy for the shield of Stefanutti, as modified by Stanich.

5. Claims 7,18,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanutti '710 in view of Stanich '918 as applied to claims 1,14,25 above, and further in

view of Anderson D330,843. Anderson teaches the use of a padlock shield member resembling a police badge. Stanich also clearly teaches in Col. 6, lines 13-17 that the shield member may be formed in various shapes resembling specific objects.

Accordingly, it would have been considered an obvious matter of design choice to modify the shield of Stefanutti by providing a shape resembling a police badge as clearly taught by Stanich and Anderson.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-7,13-18, 23,25-31,36,37,40-53 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's amendments, and upon further review, the previously applied Stefanutti reference is now applied to the claims in combination with the previously applied Stanich reference to clearly show a shield which extends beyond the shackle and covers a portion of the padlock body **and** the previously cited Dohanyos patent which clearly shows an upper end skirt/shroud portion to substantially encompass the padlock and shackle. Furthermore, although claims 10,21,34 had previously been indicated as having allowable subject matter prompting applicant's amendment rewriting these claims in independent form as new claims 43,47,51, upon further review, the rejection discussed above is deemed to teach the claimed features of new claims 43-53. Accordingly, claims 1-7,13-18,23,25-31,36,37,40-53 stand non-finally rejected.

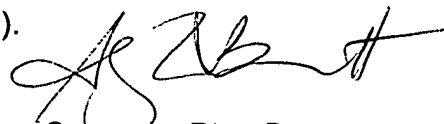
**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the upper end and side shroud of Brammall et al 6,519,982.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Suzanne Dino Barrett  
Primary Examiner  
Art Unit 3676

sdb